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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,498	07/07/2003	Alan P. Kozikowski	9328-051-999	8108
20583	7590	07/22/2004	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			REYES, HECTOR M	
			ART UNIT	PAPER NUMBER

1625

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/614,498

Applicant(s)

KOZIKOWSKI ET AL.

Examiner

Hector M Reyes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-91 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

ELECTION RESTRICTION REQUEST

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, in part, drawn to a series of heterocyclic derivatives as described in the said claims, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**
- II. Claims 1-8, in part, drawn to a series of derivatives as described in the said claims wherein R1 is aryl, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**
- III. Claims 1-8, in part, drawn to a series of derivatives as described in the said claims wherein R1 is an alkyl or cycloalkyl, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**
- IV. Claims 9-12, in part, drawn to a series of heterocyclic derivatives as described in the said claims, classified in multiple classes and multiple subclasses. **This group may be subjected to further**

restriction. A single disclosed species is hereby requested for search purpose.

V. Claims 9-12, in part, drawn to a series of derivatives as described in the said claims wherein R2 is aryl, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**

VI. Claims 9-12, in part, drawn to a series of derivatives as described in the said claims wherein R2 is an alkyl or cycloalkyl, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**

VII. Claims 13-17, in part, drawn to a series of heterocyclic derivatives as described in the said claims, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**

VIII. Claims 13-17, in part, drawn to a series of derivatives as described in the said claims wherein R3 is aryl, classified in multiple classes

and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**

IX. Claims 13-17, in part, drawn to a series of derivatives as described in the said claims wherein R3 is an alkyl or cycloalkyl, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**

X. Claim 18, in part, drawn to a series of heterocyclic derivatives as described in the said claims, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**

XI. Claim 18, in part, drawn to a series of derivatives as described in the said claims wherein R6 is aryl, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**

- XII. Claim 18 in part, drawn to a series of derivatives as described in the said claims wherein R6 is an alkyl or cycloalkyl, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**
- XIII. Claim 19, in part, drawn to a series of heterocyclic derivatives as described in the said claims, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**
- XIV. Claim 19, in part, drawn to a series of derivatives as described in the said claims wherein R7 is aryl, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**
- XV. Claim 19 in part, drawn to a series of derivatives as described in the said claims wherein R7 is an alkyl or cycloalkyl, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**

XVI. Claims 20-21 drawn to a series of derivatives as described in the said claims, classified in multiple classes and multiple subclasses.

This group may be subjected to further restriction. A *single disclosed species is hereby requested for search purpose.*

XVII. Claim 22 drawn to a series of derivatives as described in the said claim classified in multiple classes and multiple subclasses. **This**

group may be subjected to further restriction. A *single disclosed species is hereby requested for search purpose.*

XVIII. Claims 23-25, in part, drawn to a series of heterocyclic derivatives as described in the said claims, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A *single disclosed species is hereby requested for search purpose.***

XIX. Claims 23-25, in part, drawn to a series of derivatives as described in the said claims wherein R8 is aryl, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A *single disclosed species is hereby requested for search purpose.***

- XX. Claims 23-25 in part, drawn to a series of derivatives as described in the said claims wherein R8 is an alkyl or cycloalkyl, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**
- XXI. Claims 26-31 in part, drawn to a series of phenyl derivatives as described in the said claims, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**
- XXII. Claims 32-40, drawn to multiple pharmaceutical compositions as described in the said claims, classified in classes 424 and 514 and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**
- XXIII. Claims 41-80, drawn to multiple methods of treating any kind of cancer as described in the said claims, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**

XIV. Claims 81-91, drawn to multiple methods of treating any neurological disease as described in the said claims, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**

The inventions are distinct, each from the other because of the following reasons:

Inventions I-XXI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case they are different inventions because each one of the said groups are drawn to different organic compounds having different chemical structures and reactivities.

Inventions I-XXI and XXII-XXIV are related, as product and process of using the same in compositions or in treating diseases. In such case, the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case it is very well known in the art that there are multiple pharmaceutical compositions not requiring the use of the compounds embraced in the claims and that there are many methods of treating neurological diseases or

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particular kind of cancer with alternative methods that do not required the compounds described in the instant methods.

Inventions XXII, XXIII and XXIV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions because each group is drawn to a different objective: a pharmaceutical composition or method of treating different diseases.

Because these inventions are distinct for the reasons given above and the search required a given Group is not required for any of the other Groups, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

If a compound-group is elected by Applicants, and the compounds are found allowable, the examiner would be willing to rejoin a method of using the said compounds in the treatment of a single disease type; together with a non-complex pharmaceutical composition comprising the same, limited

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to the scope of the allowable compounds and provided that there are no 112 issues.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector M. Reyes, whose telephone number is (571)-272-0691. The examiner can normally be reached M-F on 9:00Am to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Rita Desai can be reached at 571-272-0684.

Hector M. Reyes, PhD JD
Reg. # P-54846
AU 1625
July 21, 2004.

RDesai
7/21/04